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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,798

09/05/2003

Peter Jones

G06.015

7103

28062 7590 08/16/2007  
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EXAMINER

RANKINS, WILLIAM E

ART UNIT

PAPER NUMBER

3609

MAIL DATE

DELIVERY MODE

08/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/656,798	JONES ET AL.	
	Examiner	Art Unit	
	William E. Rankins	3609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 19-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-18 and 31-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 19-30 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/12/04</u> .   | 6) <input type="checkbox"/> Other: _____                          |

***Detailed Action***

***Election/Restrictions***

1. Claims 1-18, 31-37 drawn to a business method for upgrading a private label account to a dual card account, which can be routed and used with existing bankcard and payment card networks and processing platforms, classified in class 705, subclass 35.
2. Claims 19-23, drawn to a method for applying for a new dual card account within the context of a purchase transaction and performing credit analysis, classified in class 705, subclass 38.
3. Claims 24-30, drawn to a method for activating a dual card, classified in class 705, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

Inventions 1 and 2 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, **invention I has separate utility such as a business method that does not require purchase transactions as required in invention II**. See MPEP § 806.05(d).

Inventions 1 and 3 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, **Invention I has separate utility such as a**

**business method that does not require updating a risk profile as required in invention III. See MPEP § 806.05(d).**

Inventions 2 and 3 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, **Invention III has separate utility such as a business method that does not require a temporary card or a purchase transaction as required in invention III. See MPEP § 806.05(d).**

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Attorney Kurt M Maschoff on August 7, 2007 a non-provisional election was made without traverse to prosecute the invention of Group I (claims 1-19 and 31-37). Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Priority***

1. The instant application claims priority as a continuation but contains multiple instances of new matter and is seen to be a continuation-in-part of application 09/593,199 now patent # US 6,915,277 filed June 14, 2000. The new matter will be given priority only to the filing date of the instant application filed Sept. 5, 2003.

2. A review of the claims and updated search necessitated the rejections below.

### ***Nonstatutory Double-Patenting Rejections***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is

Art Unit: 3609

shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. The claims 31 and 32 are rejected under the judicially created doctrine of the obviousness-type double patenting of the claim in applicant's prior U. S. Patent No. 6,915,277. Although the designs are not identical, they are not patentably distinct from each other because in claims 9 and 10 of US 6,915,277 the authorization request includes an amount and information identifying a credit card account. All of which is comprised in claims 31 and 32.. Claims 31 and 32 of the application also reference a dual card-processing platform while claim 9 and 10 of the referenced patent refers to processing via a cooperating bankcard back office operation. The dual card network of the examined application is not patentably distinct from the network in the referenced patent.

It is well settled that it is unobviousness in the overall appearance of the claimed design, when compared with the prior art, rather than minute details or small variations in design as appears to be the case here, that constitutes the test of design patentability. See *In re Frick*, 275 F2d 741, 125 USPQ 191 (CCPA 1960) and *In re Lamb*, 286 F2d 610, 128 USPQ 539 (CCPA 1961).

5. The claim 33 is rejected under the judicially created doctrine of the obviousness type double patenting of the claim(s) in United States Patent No. 6,915,277 in view of Fitzmaurice et al. (6,742,704 B2). At the time applicant made the design, it would have been obvious to a designer of ordinary skill in the art to identify an account and its associated accounts as valid or invalid. as demonstrated by Fitzmaurice et al. (Col. 12, lines 15-21).

6. The claim 34 is rejected under the judicially created doctrine of the obviousness type double patenting of the claim(s) in United States Patent No. 6,915,277 in view of Spear (US 2002/0138428). At the time applicant made the design, it would have been obvious to a designer of ordinary skill in the art to apply stand in authorization rules as demonstrated by Spear (Col. 3, paragraph 0023).

This modification of the primary reference in light of the secondary reference is proper because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other. See *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982); *In re Carter*, 673 F.2d 1378, 213 USPQ 625 (CCPA 1982), and *In re Glavas*, 230 F.2d 447, 109 USPQ 50 (CCPA 1956). Further, it is noted that case law has held that one skilled in the art is charged with knowledge of the related art; therefore, the combination of old elements, herein, would have been well within the level of ordinary skill. See *In re Antle*, 444 F.2d 1168, 170

Art Unit: 3609

USPQ 285 (CCPA 1961) and *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1982).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 16 are rejected under 35 U.S.C. 102(b) as being unpatentable over "The fight for retail credit". Credit Card Management, 13(9), 40-45(2000, December) by Jason Fargo (Fargo)

As per claim 1;

Fargo discloses:

A method, comprising: selecting a private label account maintained on a first processing platform for upgrade to a dual card account, said private label account associated with an account holder and having associated monetary and non-monetary data (Pg. 2, paragraph 1); creating said dual card account with a zero balance on a second processing platform (Pg. 2, paragraph 2); transferring said non-monetary data associated with said private label account to said second processing platform for association with said dual card account (examiner asserts that in converting proprietary card accounts to co-branded



Art Unit: 3609

accounts that non-monetary data would be transferred from the previous processing platform to the new platform of the issuing bank); and causing a dual card associated with said dual card account to be transmitted to account holder (Pg. 6, paragraph 4), said dual card and said dual card account being inactive until activated.

As per claim 2;

Fargo discloses:

The method of claim 1, wherein said selecting a private label account for upgrade further comprises: receiving a conversion request from said cardholder (Pg. 5, paragraph 5), said request received by at least one of: a front line associate; an interactive voice response unit; and a Web site.

As per claim 3;

Fargo discloses:

The method of claim 1, wherein said selecting a private label account for upgrade includes selecting a plurality of private label accounts for upgrade, the method further comprising: creating a plurality of dual card accounts with a zero balance on said second processing platform; transferring said non-monetary data associated with said plurality of private label accounts to said second processing platform for association with said plurality of dual card accounts; and causing a plurality of dual cards associated with said plurality of dual card accounts to be transmitted to said account holders, said plurality of dual cards and dual card accounts being inactive until activated.

Examiner cites the references of claims 1 wherein Sears and Target represent a plurality of private-label accounts.

As per claim 4;

Fargo discloses:

The method of claim 1, further comprising: communicating, to said plurality of cardholders, an opportunity to upgrade said private label account to said dual card account (Pg. 5, paragraph 5).

As per claim 16;

Fargo discloses:

The method of claim 1, further comprising: creating said dual card. (Pg. 2, paragraph 1)

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claim 14 is rejected under 35 U.S.C. 102(a) as being unpatentable over the Kmart MasterCard disclosed by "The fight for retail credit". Credit Card Management, 13(9), 40-45(2000, December) by Jason Fargo (Fargo) and "Kmart Platinum Rocks!" Posted by: Jazzy Jazz, Date: 2/25/2003

Art Unit: 3609

As per claim 14;

Fargo does not disclose:

The method of claim 1, wherein said private label account is associated with a private label merchant, the method further comprising: generating account information associated with said dual card account, said account information including an overall credit limit and a retailer reserve presented to said account holder, said retailer reserve usable for purchases at said private label merchant.

However, cardoffers.com discloses the following about the Kmart MasterCard: "It is kind of confusing at first staying within the split limit, but they did start me out with a \$500 limit, \$300 which could be used outside of Kmart."

11. Claim 15 is rejected under 35 U.S.C. 102(a) as being unpatentable over Kmart MasterCard as disclosed by "The fight for retail credit". Credit Card Management, 13(9), 40-45(2000, December) by Jason Fargo (Fargo), "Kmart Platinum Rocks!" Posted by: Jazzy Jazz, Date: 2/25/2003 and "Kmart MasterCard (9/26/00)"

As per claim 15;

Fargo does not disclose:

The method of claim 14, wherein said generating account information further comprises generating a rate associated with said dual card account.

However, cardweb.com discloses: "Kmart MasterCard cardholders will receive benefits such as special promotions and a 0% interest rate for six months on all Kmart purchases made with the new

Art Unit: 3609

MasterCard. The APR for non-Kmart purchases and for Kmart purchases after the intro period is prime +10.3%. There is no annual fee for the new MasterCard."

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over "The fight for retail credit". Credit Card Management, 13(9), 40-45(2000, December) by Jason Fargo (Fargo) in view of Official Notice.

As per claim 5;

Fargo discloses:

The method of claim 1, further comprising: receiving an activation request from said account holder...(Pg. 5, paragraph 5);

Fargo does not disclose:

... confirming that said account holder remains eligible for said dual card account; and activating said dual card account.

However, Official Notice is taken that it was old and well known in the art at the time of this invention that responses to pre-approved offers for credit would be subject to further verification prior to acceptance or activation.

Therefore it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the teaching of Fargo with the verification in the Official Notice to limit credit risk.

As per claim 12;

Fargo does not explicitly disclose:

The method of claim 4, further comprising: determining that said account holder has not declined said opportunity by determining that a time period for declining said opportunity has expired.

However, Official Notice is taken that it was old and well known in the art to limit the time for acceptance or use of special offers. One of ordinary skill in the art would have been motivated to do so in order to receive the greatest number of applications in the shortest possible time. See MPEP 2144.03

13. Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over "The fight for retail credit". Credit Card Management, 13(9), 40-45(2000, December) by Jason Fargo (Fargo) in view of Official Notice and further in view of Steele et al. (2005/0021456 A1).

As per claim 6;

Art Unit: 3609

Fargo does not disclose:

The method of claim 5, further comprising: retrieving said non-monetary data from said second processing platform; and confirming with said account holder that said non-monetary data is accurate.

However, Steele et al. discloses: (pg. 4, paragraph 0037) "In step 220, information is sent regarding the converted financial institution account to the customer. Information may be sent for the customer's review and also a confirmation from a customer may be required. The information may be forwarded to the customer in a number of ways, including, for example, email or regular mail".

Therefore it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the dual card cited in Fargo with the verification method of Steele et al. in order to provide security to the card holder and the issuer and prevent fraudulent activity.

14. Claims 7-10, 13, 17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over "The fight for retail credit". Credit Card Management, 13(9), 40-45(2000, December) by Jason Fargo (Fargo) in view of Fitzmaurice et al. (6,742,704 B2).

As per claim 7;

Fargo does not disclose:

The method of claim 5, further comprising: transferring said monetary data from said first processing platform to said second processing platform; and blocking said private label account from further use.

However, Fitzmaurice et al. discloses combined card services that, in the replacement process, transfer account information from one system to another.

(col. 8, line 65 – col. 9, line 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention that the replacement of existing cards with a dual card necessarily incorporates transferring data from one system to another and de-activating the previous card while issuing a new one.

As per claim 8;

Fargo does not disclose:

The method of claim 7, further comprising: initiating a trailing activity process to identify monetary and non-monetary activity associated with said private label account.

However, Fitzmaurice et al. discloses (col. 3, line 20-25), "It would also be advantageous to have a card that contains a bar code that may be scanned at the point of sale when customers make purchases so that the scanned data may be forwarded directly to the service partner's systems for reporting and tracking purposes."

Therefore, It would have been obvious to one of ordinary skill in the art at the time of this invention to combine the dual cards cited in Fargo with the tracking method cited in Fitzmaurice et al. to enable the card issuer to compile information about cardholders to use for marketing and fraud prevention purposes.

As per claim 9;

Fargo does not disclose:

The method of claim 8, wherein said initiating said trailing activity process includes updating a cross reference table associating said private label account and said dual card account.

However, Fitzmaurice et al. discloses, in a multiple-service card system, (Abstract) "This multiple-service card may have the traditional credit card data on one side of the card, including, for example, the account number, name of the account holder, and the expiration date. The other side of the card may include a magnetic stripe that contains the account information in machine-readable form as well as membership information suitable to permit entry into a service partner's facility.

Therefore, It would have been obvious to one of ordinary skill in the art to include the method of Fitzmaurice et al. in the creation of a dual cards cited by Fargo in order to associate activity in one account with activity in the other.

As per claim 10;

Fargo does not disclose:

The method of claim 1, wherein said non-monetary data includes data identifying said cardholder.

However, Fitzmaurice et al. discloses: (abstract) This multiple-service card may have the traditional credit card data on one side of the card, including, for example, the account number, name of the account holder, and the expiration date. The other side of the card may include a magnetic stripe that contains the account information in machine-readable form as well as membership information suitable to permit entry into a service partner's facility.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to include the method of Fitzmaurice et al. in the creation of a dual cards cited by Fargo in order to properly identify the cardholder.



As per claim 13;

Fargo does not disclose:

The method of claim 1, wherein said private label account is identified by a private label account identifier and said dual card account is identified by a dual card account identifier, the method further comprising: generating a table including a cross-reference between said private label account identifier and said dual card account identifier.

However, Fitzmaurice et al. discloses account identifiers associated with a cardholders account and used to create new account numbers to aid in the creation of a new card for that cardholder. (Col. 7, lines 10-15, Col. 9, line 53- 59, Col. 9, line 67 – col. 10, line 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to include the method of Fitzmaurice et al. in the creation of a dual cards cited by Fargo in order to associate the private-label merchant with the major credit card provider.

As per claim 17;

Fargo does not disclose:

The method of claim 16, wherein said creating said dual card includes at least one of: (1) embossing a magnetic stripe card with said account holder information and a dual card account identifier; and (2) storing information identifying said account holder and a dual card account identifier in a memory of a smart card.

Art Unit: 3609

However, Fitzmaurice et al. discloses (abstract) "This multiple-service card may have the traditional credit card data on one side of the card, including, for example, the account number, name of the account holder, and the expiration date. The other side of the card may include a magnetic stripe that contains the account information in machine-readable form as well as membership information suitable to permit entry into a service partner's facility."

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to include the method of Fitzmaurice et al. in the creation of a dual cards cited by Fargo in order to provide the functionality of two card issuers in one card.

As per claim 18;

Fargo does not disclose:

The method of claim 1, wherein said dual card account has a dual card account identifier routable over both a private label network and a bankcard network.

However, Fitzmaurice et al. discloses (Summary of the Invention, paragraph 1), The present invention provides a system and method for providing consumers with the benefits of multiple cards while allowing consumers to carry a single card. To accomplish this advantage, the system and method of the present invention enables a single card to function in multiple modes, for example, as both a credit card and a separate service partner's membership card. By providing a system of back-end functionality that takes advantage of cooperation between the multiple service providers, the present invention eliminates the disadvantages of the prior art systems such as, for example, the requirement to join, through use of a hinge and a fastener, multiple card segments or the requirement to embed multiple magnetic stripes into the consumer's card.

(Col. 5, lines 49-53) The primary party 102 and the service partner 106 both comprise computing units or systems, which communicate with and through a card service engine 104, and all of which are connected with each other via a data communication network.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to include the method of Fitzmaurice et al. in the creation of a dual cards cited by Fargo in order to provide the functionality of two card issuers in one card and facilitate purchase transaction activity.

15. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over "The fight for retail credit". Credit Card Management, 13(9), 40-45(2000, December) by Jason Fargo (Fargo) in view of Fisher et al. (US 2003/0139978)

As per claim 11;

Fargo does not disclose:

The method of claim 1, wherein said selecting further comprises:  
updating a status flag associated with said private label account to indicate that said account has been selected for said conversion to said dual card account.

However, Fisher et al. discloses; (Abstract, paragraph 1) "A method and system for providing order status information using an update status flag..."

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Fargo with the method of Fisher et al. in the selection of private-label cardholders that were offered upgrades to dual card accounts for tracking purposes.

16. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over "The fight for retail credit". Credit Card Management, 13(9), 40-45(2000, December) by

Art Unit: 3609

Jason Fargo (Fargo) in view of Blagg (US 2004/0049452 A1)

As per claim 35:

Fargo discloses:

Selecting a private label account maintained on a first processing platform for upgrade to a dual card account, said private label account associated with an account holder and having associated monetary and non-monetary data (Pg. 2, paragraph 1); creating said dual card account with a zero balance on a second processing platform (Pg. 2, paragraph 2); transferring said non-monetary data associated with said private label account to said second processing platform for association with said dual card account (examiner asserts that in converting proprietary card accounts to co-branded accounts that non-monetary data would be transferred from the previous processing platform to the new platform of the issuing bank); and causing a dual card associated with said dual card account to be transmitted to account holder (Pg. 6, paragraph 4), said dual card and said dual card account being inactive until activated.

Fargo does not disclose: A payment card processing apparatus, comprising: a processor; and a storage device in communication with said processor and storing instructions adapted to be executed by said processor...

However, Blagg discloses; (pg. 4, paragraph 0040) Further, computer 210 includes a communication device (not shown) that allows computer 210 to communicate via communication network 110. Such a communication device can be any device or combination of devices capable of

Art Unit: 3609

interfacing to communication network 110, such as, an internal modem, an external modem, an Ethernet card, or the like. In addition, computer 210 includes various forms of memory such as random access memory (RAM), and disk memory such as a hard disk drive. Such memory provides a computer readable medium that includes computer executable instructions that are executed by a processor of computer 210 to perform the various functions associated with transaction processor 120.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the teaching of Fargo with Blagg et al. in order to facilitate the process of establishing a dual account.

As per claim 36:

Fargo discloses:

Selecting a private label account maintained on a first processing platform for upgrade to a dual card account, said private label account associated with an account holder and having associated monetary and non-monetary data (Pg. 2, paragraph 1); creating said dual card account with a zero balance on a second processing platform (Pg. 2, paragraph 2); transferring said non-monetary data associated with said private label account to said second processing platform for association with said dual card account (examiner asserts that in converting proprietary card accounts to co-branded accounts that non-monetary data would be transferred from the previous processing platform to the new platform of the issuing bank); and causing a dual card associated with said dual card account to be transmitted to account holder (Pg. 6, paragraph 4), said dual card and said dual card account being inactive until activated.

Art Unit: 3609

Fargo does not disclose:

The means to accomplish the steps of claim 36.

However, Blagg discloses; (pg. 4, paragraph 0040) Further, computer 210 includes a communication device (not shown) that allows computer 210 to communicate via communication network 110. Such a communication device can be any device or combination of devices capable of interfacing to communication network 110, such as, an internal modem, an external modem, an Ethernet card, or the like. In addition, computer 210 includes various forms of memory such as random access memory (RAM), and disk memory such as a hard disk drive. Such memory provides a computer readable medium that includes computer executable instructions that are executed by a processor of computer 210 to perform the various functions associated with transaction processor 120.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the teaching of Fargo with Blagg et al. in order to facilitate the process of establishing a dual account.

Additionally, the examiner does not treat claim 36 as invoking 112 6<sup>th</sup> paragraph because the claim further provides a list of structures, material or acts for achieving the specified function.

As per claim 37:

Fargo discloses:

Selecting a private label account maintained on a first processing platform for upgrade to a dual card account, said private label account associated with an account holder and having associated monetary and non-monetary data (Pg. 2, paragraph 1); creating said dual card account with a zero balance on a second processing platform

Art Unit: 3609

(Pg. 2, paragraph 2); transferring said non-monetary data associated with said private label account to said second processing platform for association with said dual card account (examiner asserts that in converting proprietary card accounts to co-branded accounts that non-monetary data would be transferred from the previous processing platform to the new platform of the issuing bank); and causing a dual card associated with said dual card account to be transmitted to account holder (Pg. 6, paragraph 4), said dual card and said dual card account being inactive until activated.

Fargo does not disclose:

A medium storing instructions adapted to be executed by a processor to perform a payment card processing method.

However, Blagg discloses; (pg. 4, paragraph 0040) Further, computer 210 includes a communication device (not shown) that allows computer 210 to communicate via communication network 110. Such a communication device can be any device or combination of devices capable of interfacing to communication network 110, such as, an internal modem, an external modem, an Ethernet card, or the like. In addition, computer 210 includes various forms of memory such as random access memory (RAM), and disk memory such as a hard disk drive. Such memory provides a computer readable medium that includes computer executable instructions that are executed by a processor of computer 210 to perform the various functions associated with transaction processor 120.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the teaching of Fargo with Blagg et al. in order to facilitate the process of establishing a dual account.

Art Unit: 3609

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM, off alt Fridays beg 6/15/07.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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William E Rankins

Examiner

Art Unit 3609

  
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